

4. (Not Amended Herein) A recording method comprising the steps of:
performing ink-jet recording on the recording medium according to Claim 1;

and

heating the recording medium after the ink-jet recording.

5. (Not Amended Herein) A recording method according to Claim 4, wherein
recording is performed on both surfaces of the recording medium.

REMARKS

Favorable reconsideration and allowance of the subject application are
respectfully solicited.

Claims 1-5 are pending in this application, with Claim 1 being the only
independent claim. Claims 4 and 5 are withdrawn from consideration. Claim 1 is amended
herein to highlight distinctions between the present invention and the cited art. Support for this
amendment may be found at least at page 9, lines 1-15, and page 12, line 32. Claim 3 is
amended to more clearly recite the subject matter of the present invention, without narrowing its
scope. No new matter has been added by the amendments herein.

Applicant hereby affirms the provisional election, with traverse, of Group I,
Claims 1-3, for prosecution on the merits. However, Applicant respectfully requests that the
Examiner reconsider and withdraw the Restriction Requirement. It is not mandatory for the
Examiner to make a Restriction Requirement in every possible situation, and the additional

search required for the other Group would be minimal. Moreover, all of the claims can be searched by one Examiner without undue effort and a duplicative search by two Examiners may possibly produce inconsistent results. In addition, it is believed that if one Examiner acts on all the claims of the present application, overall examining time will be less than if two Examiners are involved. Therefore, in the interest of prosecution quality and economy for both the Office and Applicant, withdrawal of the restriction requirement in this application is appropriate and is respectfully solicited.

Claim 3 was rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Without conceding the propriety of this rejection, Claim 3 is amended herein in accordance with the Examiner's suggestion. Applicant submits that the specification and claims comply with all aspects of Section 112 and respectfully requests that this rejection be withdrawn.

Claims 1-3 stand rejected under 35 U.S.C. 103(a) as allegedly obvious over either U.S. Patent No. 6,203,899 (Hirose et al.) or U.S. Patent No. 6,214,449 (Otani et al.) taken either alone or in view of either U.S. Patent No. 6,180,238 (Malhotra) or U.S. Patent No. 4,554,181 (Cousin et al.).

Initially, it is noted that the Otani et al. patent does not qualify as prior art with respect to the present application. The present application is entitled to an effective filing date of January 7, 1999, based on Japanese Application No. 001832/1999. A Claim to Priority and certified copy of the Japanese Application were filed on March 10, 2000. Applicant will undertake to file a Certified English Translation of it in the near future. Withdrawal of the rejection based on the Otani et al. patent respectfully is requested.

Before addressing the merits of the rejections based on the Hirose et al. patent, Applicant believes it will be helpful to review some features of the claimed invention. The present invention, as recited in independent Claim 1, relates to a recording medium comprising an ink receiving layer containing an inorganic pigment and an outermost surface layer containing a thermoplastic latex resin. The ink receiving layer and the outermost latex surface layer are provided on both surfaces of the substrate. The outermost latex surface layer forms a transparent film upon heating of the recording medium.

In Applicant's view, the cited references do not teach or suggest the claimed invention. Specifically, none of the references disclose that the outermost latex surface layer forms a transparent film upon heating of the recording medium, as recited in independent Claim 1.

The Hirose et al. patent is directed towards a printing medium, and ink-jet printing process and image-forming process using the same. The printing medium is disclosed as comprising an ink-receiving layer provided on a liquid-absorbent base material. The ink-receiving layer comprises a pigment, a binder and a cationic substance. A surface layer provided on the ink-receiving layer is composed principally of cationic ultra fine particles as inorganic particles. Applicant submits, however, that the Hirose et al. patent fails to disclose or suggest that, inter alia, the outermost latex surface layer forms a transparent film upon heating of the recording medium.

The Malhotra patent, and the Cousin et al. patent were both cited by the Examiner for teaching coating both the front and back surfaces of the base material; however, neither of these references remedies the deficiencies of the Hirose et al. patent set forth above. While both

references mention that the base material or substrate may be transparent (Malhotra, at col.11, line 18; Cousin et al., at col.7, line 34), it is submitted that there is no mention that the outermost latex surface layer forms a transparent film upon heating of the recording medium.


Accordingly, Applicant concludes that the Hirose et al. patent, the Malhotra patent, and the Cousin et al. patent, whether taken alone or in combination, do not teach or suggest at least the feature that the outermost latex surface layer forms a transparent film upon heating of the recording medium, as recited in amended independent Claim 1. Thus, withdrawal of the Section 103 rejections is respectfully requested.

Applicant submits that the present invention is patentably defined by independent Claim 1. The dependent claims are allowable for the reasons given with respect to independent Claim 1 and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

In view of the above amendments and remarks, the claims are now in allowable form. Therefore, rejoinder of withdrawn Claims 4 and 5 and early passage to issue are respectfully solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE TO THE CLAIMS

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1. (Twice Amended) A recording medium comprising:
a substrate having two surfaces;
an ink receiving layer containing an inorganic pigment; and
an outermost surface layer containing a thermoplastic latex resin, in this order,
wherein said ink receiving layer and said outermost latex surface layer are
provided on both surfaces of the substrate and the outermost latex surface layer forms a
transparent film upon heating of the recording medium.

3. (Twice Amended) A recording medium according to Claim 1, wherein [a] the
difference in [an] the amount of coating between said ink receiving layers on the two surfaces of
the substrate is equal to or less than 15 g/m².